

REMARKS

This responds to the Office Action dated February 2, 2007. By this response, claims 1, 14, 18 and 20 have been amended and claim 27 has been canceled. As a result, claims 1-26 remain pending in this application. Reconsideration of this application is requested in view of the above amendments and the following remarks.

Claim Objections

Objection: Claims 1, and 14 were objected to for informalities.

Response: Claim 1 was amended to include “a first outer perimeter” and “a second outer perimeter”, respectively, as suggested by the Examiner. Claim 14 was amended to include “a space” so as to appropriately introduce an element with the indefinite modifier. These amendments overcome the Examiner’s objections to claims 1 and 14.

§102 Rejection of the Claims

A. Rejection: Claims 1-4, 7, 8, and 11-19 were rejected under 35 U.S.C. § 102(b) for anticipation by Thompson (U.S. Patent No. 3,875,712).

B. Response: Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, A[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.* @ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Claim 1, as now amended, recites "...a spacing element ... positioned to abut an outer perimeter of the first frame member and an outer perimeter of the second frame member; and a flashing element associated with one of the first frame member or the second frame member, at least a portion of the flashing element positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member, the flashing element having a length substantially equal to the length of the first frame member or the second frame member." The Thompson reference fails to show several of the features as now claimed.

Simply put, the Thompson fails to teach a flashing element, much less a flashing element positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member. The Examiner contends that element 52 of the Thompson reference is a flashing element. However, according to the specification of the Thompson reference, the element 52 is a leg for the deck structure.

"Support legs referred to generally at 52 are provided at each corner of each deck frame 13 as illustrated in FIG. 2 and the lateral members at the ends 28 and 29 of the frame as well as the longitudinally extending members 15 and 16 adjacent their ends are provided with openings 18a and 25a so that suitable screws or bolts 52a or the like may be secured through the openings in the upper end of the **support legs 52** as shown in FIG. 2 for securing the legs to the frame, and for securing adjacent deck frames together as previously described." (See column 3, lines 1-11 of the Thompson reference).

The Applicant contends that the Examiner's characterization of the element 52 as a flashing element is incorrect. Applicant requests that the Examiner explain more fully how a support leg is comparable to the flashing element of the invention as claimed. Applicant fails to see how element 52 (a support leg for a deck) "...under broadest reasonable interpretation, is a flashing element..." (see page 11, lines 2-7). Applicant contends that even if the Examiner is allowed the broadest reasonable interpretation, he can not convert a support leg into a flashing element. Applicant contends this is simply beyond the broadest reasonable interpretation.

Claim 1 has also been amended to recite that the flashing element has a length substantially equal to the length of the first frame member or the second frame member. This amendment is for the purposes of further distinguishing the structure of the flashing element

from the support leg 52 of the DECK FRAME AND SYSTEM of Thompson. This amendment renders the claim more clear and should be entered to more clearly define the claims for appeal. It should be noted that this further distinguishes the flashing element from the support leg 52 of Thompson.

Thompson also does not show "...a spacing element positioned to abut a first outer perimeter of the first frame member or a second outer perimeter of the second frame member as recited in the claim. The element recited by the Examiner as the spacing element is referred to by the Thompson reference as "framing members 25" (see column 2, line 50 of Thompson). Thompson teaches making grooves in the joist so that it can sit within a channel of member 15. If the bottom portion of the channel of member 15 or 25 is considered the spacing member, the deck system of Thompson fails to teach a spacing element that abuts the outer perimeter of one of the first frame member or the outer perimeter of the second frame member.

As a result, Thompson fails to anticipate claim 1 since Thompson fails to disclose each element of the claim under consideration, arranged as in the claim. As a result, claim 1 now overcomes the Examiner's rejection under 35 U.S.C. § 102(b) as being anticipated by Thompson (U.S. 3,875,712). Claims 2-4, 7, 8, 11-13 depend from claim 1 and include the recitations of claim 1 by their dependency. As a result, claims 2-4, 7, 8, 11-13 now also overcome the Examiner's rejection under 35 U.S.C. § 102(b) as being anticipated by Thompson (U.S. 3,875,712).

Claim 14 recites "A ledger element comprising...a spacing element associated one of the first and the second edge, the spacing element abutting one of the first edge and the second edge; and a flashing element associated with the other of the first edge and the second edge of the ledger element, the flashing element positioned outside a space between the first edge and the second edge, the flashing element having a length substantially equal to a length of the ledger element." The element recited by the Examiner as the spacing element is referred to by the Thompson reference as "framing members 25" (see column 2, line 50 of Thompson). Thompson teaches making grooves in the framing member so that it can sit within a channel of member 15. If the bottom portion of the channel of member 15 or 25 is considered the spacing member, the

deck system of Thompson fails to teach a spacing element that abuts one of the first edge or the second edge. In the Thompson reference spacing element and the edge are the same element.

In addition, Thompson also fails to teach a flashing element, much less a flashing element positioned outside the space between the first edge and the second edge and a flashing element that has a length substantially equal to a length of the ledger element. The Examiner states that element 52 is the flashing element. The specification states that element 52 is a support leg. The portion of the specification where this is stated is set forth above. Basically, even given the broadest reasonable interpretation, a support leg can not be equated to a flashing element. Claim 14 has been further amended to state that the flashing element has a length substantially equal to a length of the ledger element. This further distinguishes the support leg 52 of Thompson from the ledger invention set forth in claim 14.

As a result, Thompson fails to anticipate claim 14 since Thompson fails to disclose each element of the claim under consideration, arranged as in the claim. As a result, claim 14 now overcomes the Examiner's rejection under 35 U.S.C. § 102(b) as being anticipated by Thompson (U.S. 3,875,712). Claims 15-19 depend from claim 14 and include the recitations of claim 14 by their dependency. As a result, claims 15-19 now also overcome the Examiner's rejection under 35 U.S.

C. Rejection: Claims 1, 8 and 10 were rejected under 35 U.S.C. § 102(b) for anticipation by Zamerovsky (U.S. Patent No. 5,533,310).

D. Response: The criteria for a rejection under 35 U.S.C. § 102(b) are set forth in the B. Response section above). Claim 1, as now amended, recites "...a spacing element ... positioned to abut an outer perimeter of the first frame member or an outer perimeter of the second frame member; and a flashing element associated with one of the first frame member or the second frame member, at least a portion of the flashing element positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member." The Zamerovsky reference fails to show several of the features as now claimed.

Zamerovsky fails to teach a flashing element, much less a flashing element positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member. The Examiner states that elements 85 and 86 of Zamerovsky According to Zamerovsky, elements 85 and 86 are faces that are formed from two of the three cuts needed to make a seat for the subflooring. There is no teaching of any type of a flashing element. The surfaces will not keep moisture away from any joint in the deck. In fact the surfaces will be more likely to introduce moisture into the joints or surfaces. According to the Webster's Universal College Dictionary, flashing is defined as "...pieces of sheet metal or the like used to cover and protects certain joints and angles...against leakage." The elements 85 and 86, as noted above are not like sheet metal and are not placed to protect any joint against leakage. Therefore, the elements 85 and 86 of the Zamerovsky reference can not be termed as flashing. These are merely surfaces associated with the seat formed by three cuts (see column 4, lines 25-38 of Zamerovsky). In addition, even if the cuts associated with the seat 80 is somehow termed a "flashing element" per the Examiner's contention, the resulting flashing element of Zamerovsky is not positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member as recited in claim 1.

Zamerovsky does not show "...a spacing element positioned to abut a first outer perimeter of the first frame member or a second outer perimeter of the second frame member as recited in the claim. The element (having the reference number 31) recited by the Examiner as the spacing element is referred to by the Zamerovsky reference as "sub-flooring" (see column 3, line 65 of Zam). The upper surface of Zamerovsky may be what the Examiner is calling the spacing element. If this is the case, the frame member is also the spacing element. There is no separate spacing element taught by Zamerovsky.

As a result, Zamerovsky fails to anticipate claim 1 since Zamerovsky fails to disclose each element of the claim under consideration, arranged as in the claim. As a result, claim 1 now overcomes the Examiner's rejection under 35 U.S.C. § 102(b) as being anticipated by Zamerovsky (U.S. 5,533,310). Claims 8 and 10 depend from claim 1 and include the recitations

of claim 1 by their dependency. As a result, claims 8 and 10 now also overcome the Examiner's rejection under 35 U.S.C. § 102(b) as being anticipated by Zamerovsky (U.S. 5,533,310).

E. Rejection: Claims 20 and 22 were rejected under 35 U.S.C. § 102(b) for anticipation by Daniels (U.S. Patent No. 4,313,688).

F. Response: The criteria for a rejection under 35 U.S.C. § 102(b) are set forth in the B. Response section above). Claim 20 recites "...placing a non-wood element below an existing wood ledger, the non wood element placed along the length of the wood ledger..." The specification states that the ledger is the same as the header (see page 13, line 6 of the instant application). The Daniels reference shows placing a non-wooden element below a joist rather than the ledger or header. As a result, the Daniels reference fails to teach the element of placing a non-wood element below an existing wood ledger as recited in claim 20. As a result, Daniels fails to anticipate claim 1 since Thompson fails to disclose each element of the claim under consideration, arranged as in the claim. As a result, claim 20 now overcomes the Examiner's rejection under 35 U.S.C. § 102(b) as being anticipated by Daniels (U.S. 4,313,688). Claim 22 depends from claim 20 and include the recitations of claim 20 by its dependency. As a result, claim 20 now also overcome the Examiner's rejection under 35 U.S.C. § 102(b) as being anticipated by Daniels (U.S. 4,313,688).

§103 Rejection of the Claims

A. Rejection: Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Thompson (U.S. Patent No. 3,875,712) in view of Horn (U.S. Patent No. 3,875,707).

B. Response: In order for the Examiner to establish a prima facie case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. ' 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claims 5 and 6 depend from claim 1 and include the recitations of that claim. Claim 1 recites "...a spacing element ... positioned to abut an outer perimeter of the first frame member or an outer perimeter of the second frame member; and a flashing element associated with one of the first frame member or the second frame member, at least a portion of the flashing element positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member." The Thompson reference fails to show several of the features of claim 1 and therefore also fails to teach or suggest these same features with respect to claims 5 and 6. The Thompson reference fails to teach or suggest a spacing element positioned to abut an outer perimeter of the first frame member or an outer perimeter of the second frame member. Thompson also fails to teach or suggest a flashing element associated with one of the first frame member or the second frame member that has at least a portion (of the flashing element) positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member. The support leg of Thompson, as argued above, does not equate to a flashing element. The Horn reference does not teach or suggest these missing elements. Horn is relied on for its teaching of using a weld as an adhesive and fails to provide a teaching or suggestion of the missing elements of the claim. In addition, it should be pointed out that the Applicant disagrees with the Examiner that a weld is an adhesive. Be that as it may, the Examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Thompson (U.S. Patent No. 3,875,712) in view of Horn (U.S. Patent No. 3,875,707) is now overcome since the Examiner no longer has a proper *prima facie* case of obviousness. Simply

put, the prior art references do not teach or suggest all the claim limitations set forth in claims 5 and 6 by way of their dependency on claim 1.

C. Rejection: Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Thompson (U.S. Patent No. 3,875,712) in view of Parisien (U.S. Patent No. 5,483,773).

D. Response: Claim 9 depends from claim 1 and includes the recitations of that claim. Claim 1 recites "...a spacing element ... positioned to abut an outer perimeter of the first frame member or an outer perimeter of the second frame member; and a flashing element associated with one of the first frame member or the second frame member, at least a portion of the flashing element positioned beyond the outer perimeter of the first frame member and the outer perimeter of the second frame member." The Thompson reference fails to show several of the features of claim 1 and therefore also fails to teach or suggest these same features with respect to claim 9 (the spacing element and the flange). The Parisien reference does not teach or suggest the spacing element or the flange. As a result, claim 9 now overcomes the Examiner's rejection since the Examiner no longer has a proper *prima facie* case of obviousness. Simply put, the prior art references do not teach or suggest all the claim limitations set forth in claims 5 and 6 by way of their dependency on claim 1.

E. Rejection: Claims 21 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels (U.S. Patent No. 4,313,688) in view of Parisien (U.S. Patent No. 5,483,773).

F. Response: Claims 21 and 23 depend from claim 20 and include the recitations of claim 20 by their dependency. The Daniels reference shows placing a non-wooden element below a joist rather than the ledger or header. As a result, the Daniels reference fails to teach or suggest the element of placing a non-wood element below an existing wood ledger as recited in

claim 20. The Parisien reference also does not teach or suggest these elements. As a result, claims 21 and 23 overcome the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Daniels (U.S. Patent No. 4,313,688) in view of Parisien (U.S. Patent No. 5,483,773).

G. Rejection: Claims 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels (U.S. Patent No. 4,313,688).

H. Response: : Claims 24-26 depend from claim 20 and include the recitations of claim 20 by their dependency. The Daniels reference shows placing a non-wooden element below a joist rather than the ledger or header. As a result, the Daniels reference fails to teach or suggest the element of placing a non-wood element below an existing wood ledger as recited in claim 20. As a result, claims 24-26 overcome the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Daniels (U.S. Patent No. 4,313,688).

In addition, the Examiner is rejecting claims 24-26 based solely on Daniels appears to be improper. The Examiner rejected claims 24-26 based on U.S. Patent 4,313,688 issued to Daniels. Applicant respectfully traverses the single reference rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in the Daniels patent. Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position. As a result of all the arguments set forth above, claim 24-26 overcome the Examiner's rejection under 35 U.S.C. § 103(a) as being unpatentable over Daniels (U.S. Patent No. 4,313,688).

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6977 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,


JOHN C. FUHR

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6977

Date January 15, 2008

By


Richard E. Billion
Reg. No. 32,836

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15 day of January 2008.

Name


Signature